



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/519,570

07/22/2005

Yee-Hyeng Kim

1005.006

7284

54434

7590

10/06/2008

BOOTH UDALL, PLC  
1155 W. Rio Salado Pkwy.  
Suite 101  
Tempe, AZ 85281

EXAMINER

FONSECA, JESSIE T

ART UNIT

PAPER NUMBER

3633

MAIL DATE

DELIVERY MODE

10/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,570	<b>Applicant(s)</b> KIM, YEE-HYENG	
	<b>Examiner</b> JESSIE FONSECA	<b>Art Unit</b> 3633	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Species III in the reply filed on 8/25/08 is acknowledged.

Claims 2-3 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/25/08.

### ***Information Disclosure Statement***

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information

Art Unit: 3633

or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Specification***

The disclosure is objected to because of the following informalities:

Lines 7-8 of par. 10, it's unclear as to how the water shielding part can be shaped like a sheet as the term "sheet" is typically known to describe a continuous flat material and not a shape. Further, it's unclear how the water shielding part is a sheet.

Appropriate correction is required.

### ***Claim Objections***

Claim 6 is objected to because of the following informalities:

The limitation "the locking nail" in line 3 of the claim lacks proper antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6/1, and 6/4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3633

Regarding claim 1: The limitation "sheet-shaped wedge" found in line 8 renders the claim indefinite. It's unclear as to how the water shielding part can be shaped like a sheet as the term "sheet" is typically known to describe a continuous flat material and not a shape. Further, it's unclear how the water shielding part is a sheet. Note that claim 4 recites the water shielding part having an L-shaped body.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6/1, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Walter (US 345,089).

With regards to claim 1: Walter discloses cap (C) comprising a shielding part (body) having a sheet-shaped wedge (fig. 5).

The cap of Walter is capable of being a backflow cap for use with panels each having a tetragonal panel body; outer interlocking folds provided by folding outwardly two neighboring sides of the panel body to extend in parallel to a surface of the panel body; and inner interlocking folds provided by folding inwardly two remaining sides of the panel body opposite to the outer interlocking folds so that the inner interlocking folds extend in parallel to an opposite surface of the panel body.

The cap of Walter is capable of being installed in top ends of the outer interlocking folds of each of the panels and supported in the top ends of the outer interlocking folds by locking means when the panels are continuously seamed together by the outer and inner interlocking folds thereof that interlock with each other, wherein the shielding part is capable of preventing a backflow of water from the panel body of each of the seamed panels into gaps defined between the outer and inner interlocking folds of the seamed panels.

Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regards to claim 6/1: The limitation “each of the panels having the outer and inner interlocking folds is installed on a support surface by the locking nail used as the locking means or a separate locking clip” is directed to an intended use as the panels have not been positively claimed. The claims as presented appear to be directed solely to the backflow prevention cap.

Claims 1 and 6/1, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Brandes (Des. 385,180).

With regards to claim 1: Brandes discloses a cap comprising a shielding part (body) having a sheet-shaped wedge (fig. 1).

The cap of Brandes is capable of being a backflow cap for use with panels each having a tetragonal panel body; outer interlocking folds provided by folding outwardly

Art Unit: 3633

two neighboring sides of the panel body to extend in parallel to a surface of the panel body; and inner interlocking folds provided by folding inwardly two remaining sides of the panel body opposite to the outer interlocking folds so that the inner interlocking folds extend in parallel to an opposite surface of the panel body.

The cap of Brandes is capable of being installed in top ends of the outer interlocking folds of each of the panels and supported in the top ends of the outer interlocking folds by locking means when the panels are continuously seamed together by the outer and inner interlocking folds thereof that interlock with each other, wherein the shielding part is capable of preventing a backflow of water from the panel body of each of the seamed panels into gaps defined between the outer and inner interlocking folds of the seamed panels.

Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regards to claim 6/1: The limitation “each of the panels having the outer and inner interlocking folds is installed on a support surface by the locking nail used as the locking means or a separate locking clip” is directed to an intended use as the panels have not been positively claimed. The claims as presented appear to be directed solely to the backflow prevention cap.

***Claim Rejections - 35 USC § 103***

Art Unit: 3633

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6/4, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandes (Des. 385,180) in view of Lee (US 5,533,758).

With regards to claim 4: Brandes discloses everything previously mentioned including the shielding part (body) comprises an L-shaped hollow body with two sidewalls (fig. 1), but fails to disclose the body is supported by an adhesive as the locking means.

However, Lee discloses corner guard (10) body supported by an adhesive as the locking means (col. 5, lines 28-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the cap (corner guard) of Brandes to include adhesive as the locking means as taught by Lee in order to provide a structure with increased security between the cap (corner guard) and the corner to which it is placed.

With regards to claim 6/4: The limitation “each of the panels having the outer and inner interlocking folds is installed on a support surface by the locking nail used as the locking means or a separate locking clip” is directed to an intended use as the panels have not been positively claimed. The claims as presented appear to be directed solely to the backflow prevention cap.



***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of record is directed to panels having locking means and corner guards/protectors having hollow bodies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./

Examiner, Art Unit 3633

Application/Control Number: 10/519,570

Page 9

Art Unit: 3633

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635